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MAR 2002

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Tadaaki HARADA, et al.

Appln. No. 09/914,363

Group Art Unit: Not Yet Assigned

Confirmation No.: Not Yet Assigned

Examiner: Not Yet Assigned

Filed: August 27, 2001

For: RESIN COMPOSITION FOR SEMICONDUCTOR ENCAPSULATION,  
SEMICONDUCTOR DEVICE COMPRISING THE SAME AND PROCESS FOR THE  
PRODUCTION OF SEMICONDUCTOR DEVICE USING THE SAME

**RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS  
AND REQUEST FOR REFUND**

BOX PCT  
Commissioner for Patents  
Washington, D.C. 20231

Sir:

In the captioned application, a Notification of Missing Requirements Under 35 U.S.C. 371 was mailed on January 3, 2002. In the first section, the Notice indicates that the Oath or Declaration has been submitted and received by the U.S. PTO as an elected office. Indeed, the Declaration and Power of Attorney was submitted on August 27, 2001, as reflected on the attached PCT PTO date-stamped filing receipt. A copy of the undersigned's August 27, 2001 Transmittal Letter is likewise enclosed for reference.

However, the Notice indicates that a \$130.00 surcharge for providing the Oath or Declaration later than the 30 month period from the priority date, is required. Applicants disagree, and are not enclosing the \$130.00 surcharge. Applicants entered the national stage in

RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS  
AND REQUEST FOR REFUND  
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the United States on August 27, 2001. Thirty months from the original priority date (February 25, 1999) fell on a Saturday, August 25, 2001. As was expressly indicated in the Transmittal Letter, the submission of the Declaration concurrently with entry of the U.S. national stage under 35 U.S.C. 371, in accordance with Chapter II of the Patent Cooperation Treaty, on Monday, August 27, 2001, is sufficient to obtain the benefit of priority and is within the thirty-month time frame. Thus, no surcharge for late-filing of the Declaration is required.

Further, the Notification letter incorrectly states that additional fees of \$306.00 are due, which allegedly breakdown as \$36.00 for 4 total claims over 20, and \$270.00 for a multiple dependent claim surcharge. These calculations are incorrect. This national stage entry application filed on August 27, 2001 included 22 original claims. Claim 1 is independent, and, claims 2-22 refer to claim 1, directly or indirectly. There are no multiple dependent claims in the application as filed, and thus a \$270.00 surcharge was not required.

Moreover, the additional claim fee charge of \$36.00 for (2), not (4), claims over the allowed limit of 20, was included in the check which accompanied the national stage entry on August 27, 2001, as indicated in the transmittal letter as well as the date-stamped filing receipt. Accordingly, no further filing or processing fees are due.

In any event, even if the PTO's fee calculations were correct, a point which Applicants which do not concede, the August 27, 2001 transmittal letter expressly included an authorization to charge our Deposit Account for any underpayment or overpayment required.

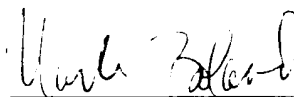
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Accordingly, to the extent this Notice seeks additional fees, it is in error for all of the above reasons.

Apparently the PTO has charged the undersigned's Deposit Account for separate fees of \$36.00, \$270.00, and \$130.00. Please refund the incorrectly charged fees, to our Deposit Account No. 19-4880.

A copy of the Notice accompanies this Response.

Respectfully submitted,



Mark Boland  
Registration No. 32,197

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Date: March 4, 2002



UNITED STATES PATENT AND TRADEMARK OFFICE

 Commissioner for Patents, Box DC1  
 United States Patent and Trademark Office  
 Washington, D.C. 20231  
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/914,363	Nitto Denko	Q65847

INTERNATIONAL APPLICATION NO.
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PCT/JP00/00951

1A. FILING DATE	PRIORITY DATE
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02/21/2000

02/25/1999

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 2100 Pennsylvania Avenue, NW  
 Washington, DC 20037-3213

**DOCKETED**

JAN 10 2002

**CONFIRMATION NO. 3899****371 FORMALITIES LETTER**

\*OC000000006960796\*

Date Mailed: 01/03/2002

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Priority Document
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Information Disclosure Statements
- Oath or Declaration

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- **\$130** Surcharge for providing the oath or declaration later than the appropriate 30 months months from the priority date (37 CFR 1.492(e)) is required.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Additionally the following defects have been observed:

- Additional claim fees of **\$306** as a non-small entity, including any required multiple dependent claim fee,

are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.

**SUMMARY OF FEES DUE:**

Total additional fees required for this application is **\$436** for a Large Entity:

- **\$130** Late oath or declaration Surcharge.
- Total additional claim fee(s) for this application is **\$306**
  - **\$36** for **4** total claims over 20.
  - **\$270** for multiple dependant claims surcharge.

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

DARRELL C COTTMAN

Telephone: (703) 305-3693

**PART 1 - ATTORNEY/APPLICANT COPY**

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09/914,363	PCT/JP00/00951	Q65847